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Applicant(s): Robert B. Hope

Docket No.

ULB-003CV

Application No.
10/033,518

Filing Date
12/28/2001

Examiner
Jerry E. Redman

Customer No.
024,902

Group Art Unit
3634

Invention: WEATHER SEAL HAVING ELASTOMERIC MATERIAL ENCAPSULATING BENDABLE CORE



I hereby certify that this Response to Notification of Non-Compliant Appeal Brief
(Identify type of correspondence)

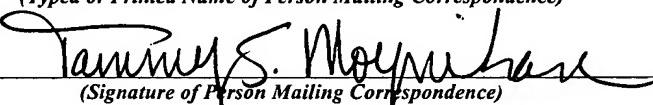
is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on

August 23, 2005

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Robert B. Hope

Serial No.: 10/033,518

Confirmation No.: 8646

Filed: December 28, 2001

For: WEATHER SEAL HAVING ELASTOMERIC MATERIALS
ENCAPSULATING A BENDABLE CORE

Examiner: Jerry E. Redman

Art Unit: 3634

Atty. Docket: ULB-003CV

RESPONSE TO NOTIFICATION OF NON-COMPLIANT APPEAL BRIEF

Mail Stop Appeal Briefs - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

A revised Appeal Brief obviating the technicalities which are noted in the Notification of Non-Compliant Appeal Brief of August 11, 2005, is enclosed in triplicate. There have been changes in the nomenclature headings in item #(7). There are no changes of substance.

As to (1) on the Notification, all 10 items under Rule 41.37(c) are in the Brief, listed by Arabic numerals instead of italics.

As to (6) of the Notification, separate headings are used for each ground of rejection noted in item (6).

As to (10), we noted that neither an Evidence nor Related Proceedings Appendix is required. Everything relied upon in the Brief, such as prior art, etc. is of record.

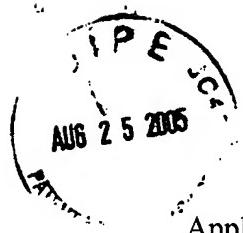
Please proceed with this Appeal.

Dated: August 23, 2005

Respectfully submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant: Robert B. Hope

Serial No.: 10/033,518

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ENCAPSULATING A BENDABLE CORE

Examiner: Jerry E. Redman

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APPEAL BRIEF UNDER Rule 41.37

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicant respectfully submits the following brief in support of his appeal of the Final Rejection of Claims 1-10 (all of the claims now standing) in the above-identified application.

(1) Real Party In Interest

Applicant's Assignee, Ultrafab, Inc., of Farmington, New York, is the Real Party In Interest in this case.

(2) Related Appeals and Interferences

There are no Appeals or Interferences related to this Appeal or to this application.

(3) Status of Claims

Claims 1-10 are pending and all of these claims are forwarded for consideration on this Appeal.

(4) Status of Amendments

A Response was filed on February 11, 2003 to the First Final Rejection of January 23, 2003. The claims were not amended in this Response. The Response contains

reasons, both factual and legal, supporting the allowance of the claims which were finally rejected and are now on appeal.

In an Advisory Action dated March 5, 2003, the Examiner maintained his Final Rejection stating, “the claims still read on the art of record”.

On or about March 10, 2003, Counsel contacted the Examiner and attempted to ascertain the basis of the Examiner’s statement in the Advisory Action. No cognizant reasons were solicited thereby predicating this Appeal.

On July 16, 2003, the Examiner issued a non-final Action citing new references and combining them to reject all of the claims under 35 U.S.C. §103(a).

In a Request for Reinstatement of Appeal and Supplemental Brief filed September 5, 2003, it was contended that reopening of prosecution only merely presenting a new non-final Action was out of order. That Request for Reinstatement and Supplemental Brief is hereby incorporated by this reference in this Second Supplemental Appeal Brief.

On June 23, 2004 (Paper 12) the Examiner responded by requiring a “new and complete brief in response to the rejection dated July 16, 2003” (the new non-final action discussed above).

The Second Supplemental Brief was submitted on July 23, 2004. As was the case after the first Appeal Brief, the Supplemental Appeal Brief was not entered or docketed.

Instead, after over three (3) years of prosecution, the Examiner issued a new non-final Action on October 20, 2004, which relied upon a new reference, a 1996 Japanese document to Iwasa, even though most of the claims were not changed since November 2002, and no reason for such lateness of citation was offered by the Examiner.

A response to the October 20, 2004 Action was filed on December 10, 2004. On March 9, 2005, the Examiner issued the second Final Rejection. New references were cited in this second Final Rejection resulting in the second and new Appeal.

This Appeal is of the latest Final Rejection of March 9, 2005.

(5) Summary of Claimed Subject Matter

This invention relates to weather seals for sealing body parts such as windows, doors and trunks of automotive vehicles (cars and trucks) (page 1, first paragraph). The invention has two aspects. The first deals with the encapsulation of the core (the wire

carrier 12, FIGS. 2 and 3) with a substrate or encapsulating filler 20 of recycled elastomeric material which is then covered with virgin elastomeric material (paragraph bridging pages 2 and 3, FIGS. 2 and 3, fourth full paragraph on page 6). Preferably, as shown in FIGS. 3 and 4, the substrate is applied as tape; preferably extruded as molten tapes 30 and 32 sandwiching the core or carrier 12 and its reinforcing elements 14 (paragraph bridging pages 6 and 7 and first full paragraph on page 7).

The principal advantage of the use of the substrate is to reduce the cost of the weather seal. Other advantages are to improve the integrity of the weather seal. These advantages are described from lines 5-25 on page 3.

The second aspect of the invention is to provide a core and carrier which avoids the need for reinforcement elements of knitted yarn (paragraph bridging pages 3 and 4). These reinforcement elements 42 are laid down only on one side of the core (the loops of the carrier 12) (page 7, lines 16 and 17). The core 12 is carried around a wheel 56 and the plurality of reinforcing elements 90 are fed onto one side of the elements on the wheel. The elements are attached to the core at a processing station 80 (FIG. 8A) as by glue from a dispenser 84 (see FIG. 11). The substrate and sealing layers are then applied over the core and the reinforcing elements (the summary and last full paragraph on page 4, and first full paragraph on page 8).

(6) Grounds for Rejection

(6)(i) 35 U.S.C. §112, Second Paragraph, Rejection

Claims 5-7 and 9-10 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

(6)(ii) 35 U.S.C. §103(a) Rejection of Claims 1, 3-5, and 8

Claims 1, 3-5, and 8 were rejected as being unpatentable over Keys, U.S. Patent No. 5,221,564 in view of Iwasa, Japanese Patent JP 0812815.

(6)(iii) 35 U.S.C. §103(a) Rejection of Claims 2, 6, 7, 9 and 10

Claims 2, 6, 7, 9 and 10 were rejected as being unpatentable over Keys in view of Iwasa and further in view of Vinay, U.S. Patent No. 5,416,961.

(7) Argument

(7)(i) Grouping of Claims

The first aspect of the invention is set forth in Claims 1-4 and 8. Claims 1 and 2 feature the dual use of recycled elastomeric material as the substrate and virgin material as the cover. An important feature of the invention is to provide the substrate of recycled elastomeric material in the form of a tape or tapes which encapsulate the core and this aspect is in Claims 3, 4 and 8. Another group is of Claims 5-7, 9 and 10. These are product by process claims which define the weather seal in terms of the use of a wheel to carry the core and define a space where the reinforcing elements are applied, the nature of these elements and the process by which they are attached, namely application of adhesive, fusion bonding, or encapsulation.

With respect to each of the claim rejections, the claims do not stand or fall together, and are in three claims groups:

Group I - Claims 1 and 2;

Group II - Claims 3, 4 and 8; and

Group III - Claims 5-7, 9 and 10.

(7)(ii) Argument over Ground of Rejection of Paragraph 6(i)

As regards the first issue, Claims 5-7, 9 and 10 are simply product by process claims. These claims are clearly understandable. No question has been raised as to clarity of the process limitations. Such limitations should not be ignored (which the Examiner appears to have done here). Accordingly, the 35 U.S.C. §112(2) rejection is respectfully submitted not to be well taken and this rejection should be reversed.

(7)(iii) Argument over Ground of Rejection of Paragraph 6(ii)

(7)(iii)(a) General

The rejection on Keys in view of Iwasa under 35 U.S.C. §103(a) is in error since there is no showing of a substrate layer of recycled elastomeric material which is

encapsulated by a covering of virgin elastomeric material, let alone the use of tapes of the recycled material, and the antithesis of what is claimed is shown in Iwasa, i.e., recycled elastomeric material (rubber) is used over a substrate of virgin rubber. Applicant claims quite the opposite relationship. Moreover, the references cited in the Final Rejection are merely general discussions of recycled rubber, and are not relevant to what Applicant claims. All the references would not even constitute a *prima facie* case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q. 2d, 1955, 1956 (Fed. Cir. 1993).

The Examiner cites, in the second Final Rejection, a litany of papers on use of recycled rubber. Such general references would not constitute evidence that would lead one of ordinary skill in the art to combine any such general references, or teachings thereof with Keys, let alone Iwasa, a reference which teaches away from what is claimed, to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q. 2d, 1596, 1598 (Fed. Cir. 1988) and In re Lintner, 458 F.2d 1013, 1016, 173 U.S.P.Q. 560, 562 (CCPA 1972).

More specifically, Iwasa uses new rubber, which is merely coated with crushed vulcanized rubber and the composite is pressure molded to provide a molding of the composite material.

(7)(iii)(b) Claim 1

The concept of covering a substrate over a core with a covering of “virgin elastomeric material” to provide a sealing surface is not present in Iwasa. Since Iwasa vulcanizes the entire body under pressure, a new element is formed, and the “covering” discussed by the Examiner is gone. The Examiner is also in error as to his interpretation of Keys. Keys shows no encapsulation layers. Layer 17 butts against the end of layer 21 at a butt joint 32. Layer 17 is of thermo setting material (noted as EPDM-apparently virgin material). Layer 21 is of thermo plastic (PVC). There is no encapsulating layer of virgin EPDM. More specifically, Keys’ layers are side by side, not in “encapsulating” relationship as contended by the Examiner in constructing his rejection. The rejection is, for the reason above, not well taken.

Claim 1 further calls for a substrate of recycled elastomeric material which is encapsulated by virgin material. Iwasa is for an integrally formed structure, nothing like

what is claimed. It is beyond peradventure that there is nothing except Applicant's disclosure to suggest (i.e., in hindsight) using a substrate of recycled material over a core covered by an encapsulating layer, let alone specifically as claimed. Clearly, the combination of references is improper under a long line of cases including In re Vaeck, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991).

(7)(iii)(c) Claims 3, 4, and 8

Claim 3 describes the recycled material of Claim 1 as being cured EPDM or TPR which is applied in molten or semi-molten form as a tape or tapes. Claim 4 and 8 further define such tape or tapes of Claim 3. For reasons argued with respect to Claim 1, neither Keys nor Iwasa, either alone or together, describe or suggest any substrate layer of recycled elastomeric material which is encapsulated by a covering of virgin elastomeric material. Iwasa is for an integrally formed structure, nothing like what is claimed.

Keys again shows no encapsulation layers. Layer 17 butts against the end of layer 21 at a butt joint 32. Layer 17 is of thermo setting material (noted as EPDM-apparently virgin material). Layer 21 is of thermo plastic (PVC). There are no claimed tapes of recycled EPDM in the Keys seal. There is no encapsulating layer of virgin EPDM. More specifically, Keys' layers are side by side, not in "encapsulating" relationship as contended by the Examiner in constructing his rejection.

Certainly the use of tapes of the elastomeric material is not foreshadowed. It is again reiterated that there is nothing except Applicant's disclosure to suggest (i.e., in hindsight) using a substrate of recycled material over a core covered by an encapsulating layer, or using tape or tapes of such recycled material. See In re Vaeck, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991).

(7)(iii)(d) Claim 5

The rejection of Claim 5 is in error in that neither Keys nor Iwasa, either alone or in combination, disclose or suggest the use of a wheel for carrying a weather seal core and applying reinforcing elements to one side of the core as the wheel rotates. Claim 5 defines a weather seal made by applying reinforcing elements along only one side of a core. Furthermore, Claim 5 is clearly distinguishable over Keys and Iwasa by virtue of

the unique location of the reinforcing elements unforeshadowed in any reference of record.

(7)(iv) Argument over Ground of Rejection of Paragraph 6(iii)

(7)(iv)(a) General

Applicant reiterates argument above over the combination of Keys and Iwasa in that there is no showing in these patents of a substrate layer of recycled elastomeric material which is encapsulated by a covering of virgin elastomeric material, let alone the use of tapes of the recycled material, and the antithesis of what is claimed is shown in Iwasa, i.e., recycled elastomeric material (rubber) is used over a substrate of virgin rubber. Applicant claims quite the opposite relationship.

The Examiner is in error in applying the Vinay patent in that Vinay shows only a woven warp of threads including a wire and a meltable thread. Vinay is discussed and distinguished from the invention claimed by Appellant on page 2, first full paragraph of the specification as filed. Certainly Vinay does not teach anything about the core encapsulating layers of recycled and virgin elastomeric material. The warp is not on one side of the core, but is woven around the core wire. Accordingly, Vinay does not provide that which is clearly absent in Keys and Iwasa. Moreover, one would not even combine Keys, Iwasa, and Vinay, where Iwasa teaches away from what is claimed.

(7)(iv)(b) Claim 2

Claim 2 depend on base Claim 1 which for reasons argue above in patentable over Keys and Iwasa, even if combined with Vinay. Clearly, the concept of covering a substrate over a core with a covering of “virgin elastomeric material” to provide a sealing surface is not present in Iwasa. Since Iwasa vulcanizes the entire body under pressure, a new element is formed, and the “covering” discussed by the Examiner is gone. Keys shows no encapsulation layers. Layer 17 butts against the end of layer 21 at a butt joint 32. Layer 17 is of thermo setting material (noted as EPDM-apparently virgin material). Layer 21 is of thermo plastic (PVC). There are no tapes of recycled EPDM in the Keys seal. There is no encapsulating layer of virgin EPDM. More specifically, Keys’ layers are side by side, not in “encapsulating” relationship as contended by the Examiner in

constructing his rejection. Iwasa is for an integrally formed structure, nothing like what is claimed. There is nothing except Applicant's disclosure to suggest (i.e., in hindsight) using a substrate of recycled material over a core covered by an encapsulating layer. Clearly, the combination of references is improper. See In re Vaeck, 20 U.S.P.Q. 2d 1438, 1442 (Fed. Cir. 1991).

(7)(iv)(c) Claims 6, 7, 9 and 10

Claims depend on base Claim 5, which is patentable over Keys, Iwasa, and Vinay since none of these patents either alone, or in combination, describe or suggest a wheel for carrying a weather seal core and applying reinforcing elements to one side of the core as the wheel rotates of Claim 5. Moreover, Claims 6, 7, 9, and 10, like Claim 5, are clearly distinguish by virtue of the unique location of the reinforcing elements unforeshadowed by Keys, Iwasa, and Vinay.

(8) Conclusion

For the foregoing reasons, the decision of the Examiner rejecting Applicant's claims should be reversed and the Examiner should be directed to pass this case to Issue.

Respectfully submitted,



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Dated: August 18, 2005

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APPENDIX

(9) Claims on Appeal

1. A weather seal comprising a core, a substrate of recycled elastomeric material encapsulating said core, a covering of virgin elastomeric material providing a sealing surface and encapsulating said core and substrate.

2. The weather seal according to Claim 1 where the core is a wire loop carrier.

3. The weather seal according to Claim 1 wherein the recycled material is cured EPDM or TPR which is applied in molten or semi-molten form as a tape or tapes.

4. The weather seal according to Claim 3 wherein the material is extruded to form said tape or tapes.

5. A weather seal comprising a core, longitudinal extension control and reinforcing elements applied along only one side of said core by carrying said core around a wheel which exposes a space thereof, applying said element through said space as said wheel rotates, and attaching said elements to said core in said space after application.

6. The weather seal according to Claim 5 wherein said core is a wire loop carrier and elements are yarns, selected from the group consisting of polyester strands, fiberglass strands, metal wires and monofilaments.

7. The weather seal according to Claim 6 wherein said attaching step is carried out by chemical bonding, with adhesive applied where said elements contact the core.

8. The weather seal of Claim 3, further comprising one or more reinforcement elements adjacent to and along the length of said core on only one side

thereof, said tape encapsulating said core and attaching said reinforcement elements to said core.

9. The weather seal of Claim 6 wherein said attaching step is carried out by fusion bonding.

10. The weather seal of Claim 6 wherein said attaching step is carried out by encapsulation of said elements and said core.

(10) Evidence Appendix - None Required

(11) Related Proceedings Appendix - None Required